

REMARKS

Claims 9-16, 20, 23, and 26-39 are currently pending. Claims 1-8, 17-19, 21-22, and 24-25, which were withdrawn in connection with the Office's restriction/election requirement, have been canceled without prejudice or disclaimer. New claims 26-39 have been added herein.

Restriction/Election Requirement and New Claims 26-39

To expedite prosecution, non-elected claims 1-8, 17-19, 21-22, and 24-25 have been canceled without prejudice or disclaimer. Nevertheless, Applicants disagree with the Office's treatment of the restriction/election requirement. The Office Action at p. 2 characterizes the traversal of the restriction/election requirement in Applicant's prior Response as being on "ground(s) that the nonelected claims 17, 20, 21, 23 and 24 are readable on the elected species." The Office's characterization is inaccurate. As described at pp. 3-4 of the prior Response, the species election was made with traverse on grounds, *inter alia*, that the Office has not identified mutually exclusive species as set forth in MPEP § 806.04(e). The Office has provided no substantive rebuttal to those arguments. The Office's comments at p. 2 emphasizing the recitation of "at least two substrates" does not address the mutual exclusivity requirement set forth in the MPEP and is further unpersuasive further, contrary to the Office's assertion, the election requirement of October 11, 2006 did not allege Species B to be directed to a "single" substrate, and instead simply emphasized that the substrate "the substrate [] is mounted on the mounting frame during the measuring of the shape of the optical surface and the processing of the optical surface." Claims directed to two or more substrates mounted on a mounting frame that otherwise meet that description would read on that species. Moreover, claim 9 would at least be generic to an embodiment with two or more substrates mounted on the mounting frame.

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New claims 26-39 have been added to round out the scope of protection sought, and it is submitted that claims 26-39 read on the elected species. Claims 26-29 are dependent claims that depend from claim 9, and claims 30-33 are dependent claims that depend from claim 23 (now amended). New independent claim 34 recites, *inter alia*, mounting the substrate on the mounting frame, measuring a property of the substrate while the substrate is mounted on the mounting frame, and processing the optical surface of the substrate while the substrate is mounted on the mounting frame, and as such clearly reads on the elected species. Claims 35-39 depend from claim 34.

#### Objection to the Title

The Office Action includes an objection to the title and includes a suggested alternative, which has been adopted. Withdrawal of the objection is requested.

#### Objection to Claim 23

The Office Action includes an objection to the claim 23 as being a substantial duplicate of claim 20. Claim 23 has been amended in a way that obviates the objection. Support for the now recited plural attachment members may be found at least at Figs. 3, 4 and 5 and at paragraphs 73 and 74 of the published application, for example (e.g., the exemplary lugs 41, lugs 141 and contact portions 241). The claims are not limited to these examples. Withdrawal of the rejection is requested.

#### Art Rejections

The Office Action includes a rejection of claims 9-15, 20 and 23 under 35 USC 102(e) as allegedly anticipated by Oshino (EP 1338911 A2). This rejection is traversed.

Claim 9 recites a method of manufacturing an optical component, the optical component comprising a substrate having an optical surface, and a mounting frame for

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mounting the substrate. The method comprises assembling the optical component by mounting the substrate on the mounting frame, measuring a shape of the optical surface of the substrate, and processing the optical surface of the substrate, wherein the substrate is mounted on the mounting frame during the measuring of the shape of the optical surface and the processing of the optical surface.

The Office alleges that feature 25 of Oshino corresponds to the claimed mounting frame, but Applicants submit that this characterization is erroneous. Feature 25 of Oshino is described therein as a "holding device 25" that comprises "multiple 'anchoring members' 22 placed at respective locations around the perimeter of the optical element 20" wherein the optical element 20 has "respective mounting ears 24 . . . extending outward from the side surface of the optical element." (See, Oshino at paragraphs 36-37, and Fig. 2a.) Oshino also describes similar anchoring members 42 in connection with Fig. 5 therein and explicitly distinguishes such anchoring members upon which the Office relies from holding frames, and explicitly states that the holding frames are different for different measuring and processing tasks. For example, Oshino states:

A key aspect of the various embodiments discussed above is the detachability of the anchoring members from the holding frame (see FIG. 5). . . . [V]arious mirror-related tasks are required, such as mirror-shape measurements, mirror-polishing, wave-front measurements, etc. *Each of these tasks typically requires that the mirror be held by a different holding frame.* Col. 13, ll. 49-56. (Emphasis added.)

Releasable attachment of the anchoring members to the holding frame can be accomplished by providing each anchoring member with a releasable attachment mechanism, or by providing the holding frame with a respective releasable attachment mechanism for each anchoring member, or both. Col 14, lines 19-24.

A representative "out of column" procedure is polishing . . . . The anchoring members (while remaining attached to the optical element) can be *mounted in another holding frame for polishing.* Col. 15, lines 10-20. (Emphasis added.)

Another exemplary "out of column" procedure that can be performed on the optical element is a coating procedure, in which coating is performed while the element is being *held (via the anchoring members) in a holding*

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*frame of the coating machine* such as a sputtering apparatus. Col. 15, lines 35-40. (Emphasis added.)

Thus, it is readily apparent from Oshino that the anchoring members disclosed therein are not properly a mounting frame but rather are members that anchor an optical element to a frame – the anchoring members and the frame are different. Attachment members are likewise different from a mounting frame under Applicant's disclosure as well. For example, exemplary attachment members (e.g., lugs 41, lugs 141 and contact portions 241) disclosed in the Applicant's disclosure serve to mount an optical element to a mounting frame. Thus, contrary to the Office's assertion, Oshino's anchoring members that constitute the holding device 25 do not properly correspond to the claimed mounting frame. Claim 1 is not anticipated by Oshino for at least this reason.

Independent claim 20 is distinguishable over Oshino at least for reasons similar to those set forth above since similar distinctions apply.

Independent claim 23 is likewise distinguishable over Oshino at least for reasons similar to those set forth above since similar distinctions are applicable. Moreover, claim 23 is further distinguishable insofar as it recites mounting the substrate on the mounting frame via plural attachment members, the attachment members being attachable to the substrate, measuring a shape of the optical surface of the substrate while the substrate is mounted on the mounting frame, and processing the optical surface of the substrate while the substrate is mounted on the mounting frame. To the extent that Oshino's anchoring members might hypothetically correspond to the claimed attachment members, Oshino does not disclose a common holding frame that is attached to an optical element during both measuring and processing.

Thus, independent claims 9, 20 and 23 are not anticipated by Oshino for at least these reasons, and withdrawal of the rejection is respectfully requested. Claims 10-15 are allowable at least by virtue of dependency from claim 9. Moreover, the Office's rejection of 861840-999025

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claim 14 does not even allege that Oshino discloses the entire subject matter of claim 14, and the rejection is plainly deficient for this additional reason.

The Office Action includes a rejection of claims 9, 10, and 13 (as best understood) under 35 USC 102(b) as allegedly anticipated by Le Saux (USP 5,581,347). This rejection is traversed.

The Office alleges that the processing disclosed in step 57 (Fig. 6) of Le Saux satisfies the claimed processing recited in the present independent claims. This allegation is erroneous. As indicated at Le Saux Col. 10, lines 7-11, this processing is processing of measurements done by a "computer means" and has nothing whatsoever to do with any type of processing an optical element in addition to a measurement. Thus, claims 9, 10 and 13 (and 20 and 23) are patentable over Le Saux for at least this reason and withdrawal of the rejection is requested.

The Office Action includes a rejection of claim 16 under 35 USC 103(a) as allegedly unpatentable over either Oshino or Le Saux in view of Malyak (USP 6,515,750). This rejection is traversed insofar as the Office's reliance on Malyak does not make up for the deficiencies of Oshino or Le Saux described above. Withdrawal of the rejection is requested.

For at least these reasons withdrawal of the above-noted rejections and allowance of claims 9-16, 20 and 23 are respectfully requested.

#### New Claims 26-39

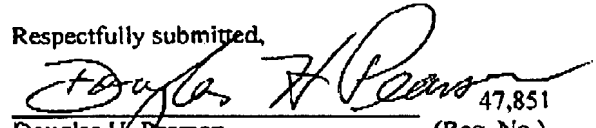
New claims 26-39 are patentable over the applied references at least for reasons similar to those set forth above, and allowance of the same is requested.

#### Conclusion

In light of the above, withdrawal of the rejections of record and allowance of this application are respectfully requested. Should there be any questions in connection with this application, the Examiner is invited to contact the undersigned at the number below.  
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